

REMARKS

Claims 1-10 have been previously canceled and claims 13, 14, 17, 19-21 and 24-28 are currently canceled. Claims 11, 15-16, 18, 23 and 29 have been amended and new claims 31-34 have been added by way of this response. Thus, claims 11-12, 15-16, 18, 22-23 and 29-34 are currently pending and presented for examination. Applicants respectfully request reconsideration and allowance of the pending claims in view of the foregoing amendments and the following remarks.

Response to Rejections Under Section 102:

Claims 11-13 and 29 stand rejected under 35 U.S.C § 102(e), the Examiner contending that these claims are anticipated by Kot (USPN 7,131,379).

Applicants' claim 11 recites in part:

...wherein the print mark **measuring device** and/or the register mark **measuring device** and/or the register **measuring device** comprises an evaluation unit ...

In contrast, Kot teaches a printing register control system where the register measuring device **13** and the evaluation unit **18** are discrete elements. The Examiner, in the instant Office Action, has incorrectly interpreted Kot as teaching the above limitations. Specifically, the Examiner has impermissibly combined elements **13**, **17** and **18** as being an integral unit. However, Kot clearly teaches a control unit **12** having a nominal value transmitter **17**, a comparator **18** and a control element **19**. The nominal value transmitter **17** is a device that provides a desired or nominal value, not a measurement device. (col. 4 lines 18-24) Separate and discrete from the control unit **12** is the register measuring device **13**. (fig. 1 and 2, col. 4 lines 10-11). Applicant's respectfully submit that Kot does not teach a measuring device comprising an evaluation unit as required by claim 11.

MPEP § 2131 requires, "TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM." As discussed above, Kot does not teach a measurement device comprising an evaluation unit as required by claim 11.

Applicants' claim 29 recites in part:

...providing a print mark **measuring device** and/or register mark **measuring device** and/or a register **measuring device** that comprises an evaluation unit...

In addition to the discussion above regarding claim 11, Kot does not teach a method of operating a printing press including providing a measurement device comprising an evaluation unit as required by claim 29.

Applicants respectfully submit that Kot does not anticipate claims 11 or 29. Furthermore, claims 12-13 which depend on claim 11 are also patentable at least based on their dependence from claim 11 as well as based on their own merits. Therefore, Applicants respectfully request that the Examiner withdraw the Section 102 rejections.

Response to Rejections Under Section 103:

Claims 14-28 and 30 stand rejected under 35 U.S.C § 103(a) as being obvious over Kot in view of Tokiwa (USPN 6626102). The Examiner contends that this claim is obvious over Goldstein in view of Baker (USPN 5,948,080).

As discussed above with regard to the Section 102 rejections, Applicants respectfully submit that Kot does not teach a measurement device comprising an evaluation unit or a method of operating a printing press including providing a measurement device comprising an evaluation unit as required by claims 11 and 29. Furthermore, Tokiwa is silent as well as having a measurement device comprising an evaluation unit as required by claims 11 and 29. Therefore, the combination of Kot in view of Tokiwa does not teach each element claimed.

MPEP 2143 requires that “the prior art included each element claimed.” In view of the above, Applicant respectfully submits that claims 14-28 and 30 are patentable at least based on their dependence from claims 11 or 29 as well as based on their own merits. Therefore, Applicants respectfully request that the Examiner withdraw the Section 103 rejections.

New Claims:

Applicants have added new claims 31-34 which further define the scope of the invention as described in the specification (para 0023-0035) and drawings (fig. 3-4). Applicants respectfully submit claims 31-34 are patentable and requests allowance of claims 31-34.

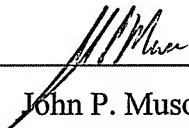
Serial No. 10/554,034
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Conclusion

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, Applicants respectfully request that the Examiner reconsider the rejections and timely pass the application to allowance. All correspondence should continue to be directed to our below-listed address. Please grant any extensions of time required to enter this paper. The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper, including fees for additional claims and terminal disclaimer fee, or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

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